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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,214	04/26/2000	Shuji Kuhara	049390-5003	9813
9629	7590	03/31/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				MATHEWS, ALAN A
ART UNIT		PAPER NUMBER		
2851				

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/558,214	KUHARA, SHUJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan A. Mathews	2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-11 is/are rejected.  
 7) Claim(s) 12 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 April 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Published European Patent Application EP 0 856 972 A in view of Kinjo et al. (U. S. Patent No. 6,219,129). The Published European Patent Application EP 0 856 972 A discloses in figure 1 a plurality of photographic processing sites (units) 3. A center 2 has a central server 12 which has a database. **Column 3, lines 7-15, disclose transferring digital image data from the laboratory to the center server. Column 5, lines 43-53, discloses storing a template on the central server. This template includes photographic printing conditions. Column 6, lines 11-23 specifically state that the template could include procedures such as “to rotate the specified picture by 90°” or “lower the saturation of the specified picture”. These are printing conditions.** Column 10, lines 16-22, further discusses the template. Column 12, lines 2-4 states that whenever a new template is generated in the laboratory, a low resolution template corresponding to the new template is also registered in the center server. **Thus, the Published European Patent Application EP 0 856 972 A teaches storing digital image data including**

**printing conditions on a central server.** Column 3, lines 30 and 52, column 4, line 6 and line 25, and column 14, lines 14-27, disclose ordering **extra prints after first prints** are received. Thus, the Published European Patent Application EP 0 856 972 A discloses the invention except for specifically stating that the printing condition sent to the center server is color or density finishing. Kinjo et al. discloses in the Abstract lines 9-16, column 2, lines 1-5, column 2, lines 17-19, column 2, lines 34-43, column 14, line 11, column 19, lines 31-41, and column 21, lines 15-25, the use of memory means 68 to store printing conditions including color and density for later use in reprinting. Column 14, lines 43-45, disclose storing this information in a data base as the memory means 68. It would have been obvious at the time the invention was made to a person having ordinary skill in the art **to include with the other printing conditions sent to the central server in the Published European Patent Application EP 0 856 972 A further printing conditions including color and density printing conditions** in view of Kinjo et al. for the purpose of making more accurate reprints, which is the explicit motivation disclosed in Kinjo et al. for storing the printing conditions in memory 68 (or a data base). With respect to Applicant's Remarks filed on January 5, 2004, it appears that Applicant is focusing his arguments on Kinjo et al. alone and that Kinjo et al. does not teach sending printing conditions to a central server for accessing from a plurality of different photographic processing sites. But this is a 103 rejection and the Published European Patent Application EP 0 856 972 A does teach sending printing conditions to a central server. We are using Kinjo et al. to add on illustrate further printing conditions that could be stored on the central server of the Published European Patent Application EP 0 856 972 A. Kinjo et al. does teach the desirability of storing the color and density printing conditions in order to make consistent reproductions for reprints.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Published European Patent Application EP 0 878 956 A1 (cited in the previous office action). Figure 1 discloses a plurality of different processing sites 1 and 2 (Dealer Branch Shop or Dealer Retail Shop). The Dealer Head Shop 5 is the center having a database. Page 3, lines 53-56 disclose editorial functions including, for example, changing into a photograph of a tone like an oil paint or watercolor picture. Other kinds of processing are available, such as sharpening of a defocus photographic picture, red-eye processing, and so forth. **Any and all types of editorial functions can be implemented in this embodiment.** These editorial functions are “printing conditions”. Page 5, lines 12-14, disclose that the user sends the editorial information to the web server 9 through the network. The head shop 5 then sends the editorial information to the branch shop 1 through the network. Page 8, lines 12-17, disclose that almost all the editorial functions, which can be dealt with by the franchisee of this system, are available for the editorial work from the user’s computer. This includes red-eye processing and oil-paint processing and sepia processing, and so forth. Page 12, lines 53-55, disclose an order for printing being given from the client, the server transfers the editorial information to the dealer’s machine which in turn automatically performs the editorial work on the high-resolution images stored therein, and prints the edited high resolution images. In addition, page 12, lines 56-58, and page 13, lines 1 and 2, disclose that the server’s end has a server function for transferring the images to the client **and a function for storing the “editorial information” which indicates the types and contents of the edition made by the client.** Thus, server 9 stores editorial information (which is the same as Applicant’s “printing conditions”). Thus, the Published European Patent Application EP 0 878

956 A1 discloses the invention except for specifically stating that the printing condition sent to the web server is color or density finishing. Kinjo et al. discloses in the Abstract lines 9-16, column 2, lines 1-5, column 2, lines 17-19, column 2, lines 34-43, column 14, line 11, column 19, lines 31-41, and column 21, lines 15-25, the use of memory means 68 to store printing conditions including color and density for later use in reprinting. Column 14, lines 43-45, disclose storing this information in a data base as the memory means 68. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the web server in the Published European Patent Application EP 0 878 956 A1 with printing conditions including color and density printing conditions in view of Kinjo et al. for the purpose of making more accurate reprints, which is the explicit motivation disclosed in Kinjo et al. for storing the printing conditions in memory 68 (or a data base). With respect to claims 5 and 10, the Published European Patent Application EP 0 878 956 A1 discloses on page 13, lines 8-11, deleting images after a predetermined period of time, which means that the printing conditions would also be deleted (why would anyone save the printing conditions of pictures but delete the pictures themselves). With respect to Applicant's Remarks, the printing conditions would apply to each original image, since the printing conditions could vary from one image to another.

*Allowable Subject Matter*

4. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for the indicated allowability of claim 12 are as follows:

The prior art of record does not disclose or suggest the accessing step comprises when one photographic processing site among a plurality of said photographic processing sites has received a request for said later printing of said one original image, inquiring said databases in said center from said one photographic processing site as to whether said photographic printing condition of said one original image at said previous printing corresponding to said request for said later printing is stored therein or not, and obtaining said photographic printing condition of said one original image from said database at said photographic processing site, if said photographic printing condition of said one original image is stored, and processing said request for said later printing of said one original image using said obtained photographic printing condition of said one original image at said photographic processing site to produce said later photographic print reproduced from said one original image in combination with all the other steps recited in dependent claim 12 and its parent claim 11.

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

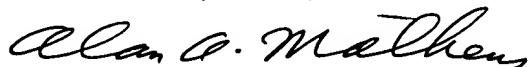
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (571) 272-2123. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (571) 272-2112. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alan A. Mathews  
Primary Examiner  
Art Unit 2851

AM